

REMARKS

I. Introduction

Claims 7-19 are pending in the above application.

Claims 7-19 stand rejected under 35 U.S.C. § 103.

Claims 7 and 13 are independent claims.

Claim 9 has been amended to depend on claim 7 as suggested by the Examiner.

No new matter has been added.

II. Prior Art Rejections

A. Claims 7-18 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Williams (U.S. Pat. 5,815,794) in view of Martin (U.S. Pat. 5,020,129).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

As explained in Applicant's previous response, neither Williams nor Martin, taken alone or in combination, disclose or suggest the limitations of independent claims 7 or 13. Williams does not disclose to selectively provide unimpeded, partially impeded,

and full cut off of cable service in the upstream or downstream and upstream paths, as recited by claims 7 and 13, respectively. The Office action appears to recognize these deficiencies of Williams. Final Office action, pg. 3.

Martin merely teaches a downstream filtering technique to selectively provide premium content channels to a user. Martin, Abs.; Fig. 1; col. 5: 19-42. Martin also is not concerned with filtering an upstream communication signal. More particularly, Martin does not disclose “a controller for selectively providing unimpeded, partially impeded, and full cut off of cable service in the upstream path, and controlling upstream gain and attenuation in the upstream path, wherein the level of attenuation depends on a maximum upstream level from an interface associated with the RF module and the selection by the controller of providing an unimpeded, partially impeded, or full cut off of cable service in the upstream path,” as substantially recited by each of claims 7 and 13.

The Office action does not appear to disagree with Applicant’s explanation of the factual teachings of the references. Yet the rejection is maintained. In doing so, the Examiner appears to attempt to provide an explanation for a standard obviousness in general. However, the explanation for maintaining the rejection does not address the fact that neither reference discloses to control an attenuation level as claimed by Applicant. At best, Martin does not operate on upstream communications, and clearly is not concerned with attenuation of such. Williams does not use a controller to provide unimpeded, partially impeded and full cut of communications, and hence clearly does not disclose to control an attenuation level based on such selection. While the Office action cites to various portions of Williams to apparently suggest performing attenuation in general, the cited portions do not discuss performing attenuation based on a selection of

cable service to be provided. Indeed, any discussion of attenuation in the cited portions, is sparse at best, and most of the discussion of controlling the upstream communications (to which the examiner appears to group controlling attenuation) in the cited portions is based on instructions from a headend rather than an internal controller. In any event, it is clear that neither reference, taken alone or in combination disclose or suggest the claimed invention.

Applicant notes that the Examiner previously held that the combination of Williams and Martin did not render claims 9, 12 or 18 unpatentable. The sudden change in position in the Office action is unwarranted as the claimed features, e.g. an upstream amplifier which provides power equalization is not seen in the cited portions of Williams.

B. Claim 19 stands rejected under 35 U.S.C. § 103 as being unpatentable over Williams in view of Martin in view of U.S. Pat. 6,678,893 (Jung).

Applicant respectfully continues to traverse this rejection for the reasons of record. Namely, the addition of Jung does not cure the deficiencies of the combination of Williams and Martin.

III. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

Respectfully submitted,

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